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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/895,095

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GROUP 3600

Duke W. Yee
Yee & Associates, P.C.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 December 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement that no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-35 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5910987	GINTER et al.	6-1999
5671412	CHRISTIANO	9-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (hereinafter Ginter), U.S. Patent 5,910,987 A1 in view of Christiano, U.S. Patent 5,671,412.

This rejection is set forth in a prior Office Action, mailed on 15 July 2004.

1. As per claims 1, 4, 33 and 34 Ginter discloses a method of digital rights management, comprising: associating a field with an electronic property, wherein the first field identifies a current owner of the electronic property (column 144, line 12 – column 145 line 49); and wherein access control software allows access to the property only upon verification that a user satisfies specified requirements for access (columns 82-83; column 135, lines 20-34). Ginter does not explicitly disclose including a field wherein a list of prior owners is compiled. Christiano, however, teaches a license management system for software application, wherein software ownership history is compiled in addition to several identifying fields with regards to various aspects of digital ownership of the property (column 3, line 10-column 5, lines 18). One of ordinary skill at the time of the claimed invention would recognize that it would be obvious to record ownerships rights to electronic property, because unlike tangible property, electronic property can be easily transferred between multiple parties and in order to protect the rights of the current

owner, it would be useful to keep a record of all owners to ensure that the proper owner is accessing the property, as per teachings of Christiano (columns 6-7; figures 1-8 and associated text).

As per the following claims, Ginter further discloses:

2. The method according to claim 1, wherein the access control software restricts use of the electronic property to the person identified as the current owner (column 83, line 63 – column 84, line 67).
3. The method according to claim 1, further comprising notifying the electronic property's manufacturer in case of property rights violations (column 42, lines 4-16; see also section describing certificates).
5. The method according to claim 4, further comprising allowing access to the property by the subsequent owner only after the current owner has electronically signed an entry identifying the subsequent owner (columns 19, 21-22).
6. The method according to claim 4, further comprising storing the information associated with the ownership transfer in a backup server (columns 17-18).
7. The method according to claim 4, further comprising sending notice of the transfer of ownership to the electronic property's manufacturer (columns 286-289).

8. The method according to claim 4, wherein the subsequent owner inherits the same access privileges as the current owner (column 57, 25-34).
9. The method according to claim 1, further comprising: if use of the electronic property is temporarily loaned by the current owner to a borrower: associating a third field with the electronic property, wherein the third field identifies the current borrower of the electronic property and designates the duration of the time period of the loan; and wherein access control software allows borrower access to the property only during the duration of the loan period (columns 55-59).
10. The method according to claim 9, wherein access control hardware restricts access to the electronic property to the person identified as borrower (columns 55-60).
11. The method according to claim 9, wherein the current owner cannot access the electronic property during the duration of the loan period (columns 55-60).
12. The method according to claim 9, further comprising storing the information about the loan in a backup server (column 2-8 see rights operating system in summary).
13. The method according to claim 9, wherein the current owner may simultaneously loan the electronic property to multiple borrowers (columns 55-61; see access control and rules and controls).

14. The method according to claim 9, further comprising sending notice of the loan to the electronic property's manufacturer (columns 83-84; see certificates as above).

15. The method according to claim 9, wherein the borrower acquires a specified portion of the owner's access privileges (columns 55-61; see access control and rules and controls).

16. The method according to claim 1, wherein the property title is stored in the same file with the digital property itself (figure 17 and associated text).

Claims 17-32 directed to a computer readable medium are rejected as above.

35. The system according to claim 33, further comprising: if use of the electronic property is temporarily loaned by the current owner to a borrower: a third register which associates a third field with the electronic property, wherein the third field identifies the current borrower of the electronic property and designates the duration of the time period of the loan; and wherein access control software allows borrower access to the property only during the duration of the loan period (see rejection under first group; columns 23-49).

(11) Response to Argument

Appellant's arguments (appeal brief pages 11-22) filed with respect to rejection of claims 1-35 under 35 U.S.C. 103(a) have been fully considered but are not persuasive.

Appellant contends that neither prior art reference, Ginter or Christiano teach or suggest the second element of independent claim 1 (corresponding claims 17, 33), namely, a field that includes a chronological list of owners with respect to the transfer of rights to electronic property between a plurality of previous owners (brief pages 11-13). Appellant's claim recites:

1. A method of augmenting digital rights management, the method comprising:
 - associating a first field with an electronic property, wherein the first field identifies a current owner of the electronic property; and
 - associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to historical order of transfer of rights to the electronic property between a plurality of previous owners; and
 - wherein access control software allows access to the property only upon verification that a user satisfies specified requirements for access, and wherein the specified requirements include the user being listed as the current owner in the first field.

At the outset, the examiner asserts that Appellant's second element/step represents nonfunctional descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed. MPEP 2106 IV B 1(b). In analyzing claim language for its limiting effect, the examiner has applied two basic steps: i) review the claim as a whole to see whether or not any descriptive material is being recited; ii) if descriptive material is found, determine how this descriptive material is being used in the claim as a whole, and ultimately conclude whether the data in question alters or reconfigures the system or method steps, or merely means something to the human mind. Id. Common limitations where nonfunctional data could be found often include those directed to sending, receiving, storing, and displaying data. Id. The second element/step of Appellant's claim recites historical ownership

data of electronic property associated with a second field. This “data” qualifies as descriptive material since it is directed to the information content of what is collected. With regards to how this descriptive material is being used, Appellant’s second field is not explicitly recited as being altered or impacted by any other field/element/step in the claim. Except for the meaning of the data to the human mind, the collection of ownership/rights transfer data would be the same with any other type of data, wherein the second field lacks any functional relationship to the first field as recited in the claim and the interrelationship of the elements in the claim as a whole. Thus, such nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Appellant argues that Christiano “merely teaches that in order to determine if a client is granted a license, the server checks if the number of licenses requested plus licenses in use by clients in the user list is less than or equal to the available number of licenses for the requested product (appeal brief pages 12-13).” On the contrary, Christiano does not merely teach a method of license management and electronic right distribution that tracks license units. Christiano principally teaches the use of a license management system and method wherein the license server creates a license database after receiving license data and/or package certificates, including a computer system’s node, address, serial number, licensee user name, or other identifier information to examine “license records to determine whether a requesting computer system should be allowed access to the digital property (column 6, line 64-column 7, line 46; column 8, lines 30-67; column 9, lines 9-64).” Therefore, since Christiano’s license server stores identifiers with respect to digital property rights for purposes of access or license violation

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notification, such transfer of rights or “list of owners”¹ as defined by Appellant is recorded regardless of whether the license is active (current owner) and allowed access or inactive (previous owner) and refused the right to use of the digital property.

Furthermore, the Appellant indicates that Christiano only includes a list of users that are currently using a software product, rather than previous owners or licensees (appeal brief page 14). Appellant’s argument is tenuous since in order for the license server in Christiano to provide access to digital property, it must necessarily store a list of active (current owner) and inactive (previous owner) licensees to allow/refuse access, allow for renewal of transfer rights upon expiration of a license term, and offer updated versions of the digital property to licensees. Therefore, licensee data is compared against a permissions database to determine whether a licensee hold a current valid license or a previously expired license (column 12, line 11- column 13, line 23).

Appellant further states that while Ginter teaches keeping records of the original and last distributor of digital property, it does not provide a list of owners having an order according to a historical order of transfer of rights to the electronic property (appeal brief pages 14-17). Ginter, on the contrary, discloses a “chain of handling an control” VDE, wherein it administers

¹ Appellant’s use of the term “owner” in the claims is perhaps unclear and indistinct with respect to digital property. “Current owner” is defined as the party who “currently owns the rights to the digital property, [wherein] ownership history is a list of prior owners (applicant’s specification page 12).”

protection of digital property rights with regards to authors of electronic content, commercial rights of distributors of content and any other rights with regards to access, distribution and enforcement of digital property (column 5, lines 28-43; column 6, lines 12-26). Unlike tangible property, the rights associated with the electronic content define ownership in digital property. As illustrated in figures 80-83 and disclosed in Ginter, a plurality of parties are typically involved in the transfer of digital property rights including, the creator, distributor, and user wherein usage, access, or transfer rights with respect to each party are recorded and utilized in enforcement of such rights. Ginter's VDE in fact administers transactions that specify protection of rights by recording, auditing, controlling and enforcing rights of users as well as authors (manufacturers), and distributors of electronic content (column 5, lines 28-43). The examiner asserts that similar reasoning invalidates Appellant's argument that neither reference² discloses a method of notifying the electronic property *manufacturer* in case of property rights violations (appeal brief pages 16-17, emphasis added).

Appellant additionally states that Ginter does not teach storing information upon transfer of rights from "the current owner to a subsequent owner," wherein the information about the subsequent owner includes a time period of ownership for the subsequent owner (appeal brief pages 17-19). Ginter's VDE "supports trusted chain of handling capabilities for pathways of distributed electronic information and/or content usage related information [wherein] such chains may extend, for example, from a content creator, to a distributor, a redistributors, a client user, and then may provide a pathway for securely reporting the same and/or differing usage information to one or more auditors, such as to one or more clearinghouses and then back to the

² The examiner has only cited Ginter in further rejecting dependent claim 3 and corresponding claim 19.

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content providers, including content creators (column 23, lines 23-64).” In fact, Ginter teaches the use of regular and wide bitmap meters³ that record usage and purchase information for “maintenance of usage history for (a) rental, (b) flat fee licensing or purchase, (c) licensing or purchase discounts based upon historical usage variables (column 23, line 65-column 24, line 9).”

Finally, applicant argues that Ginter “only teaches that notices are provided to the provider when the content is modified, hidden, added or deleted and/or nature” and fails to teach sending notice to the electronic property’s manufacturer of the transfer of ownership (appeal brief pages 20-21). Ginter, on the contrary, teaches the use of a flexible and modular audit⁴

³ Bitmap meter methods record activities associated with electronic appliances, properties, objects, or portions thereof, and/or administrative activities that are independent of specific properties, objects, etc., performed by a user and/or electronic appliance such that a content and/or appliance provider and/or controller of an administrative activity can determine whether a certain activity has occurred at some point, or during a certain period, in the past (for example, certain use of a commercial electronic content product and/or appliance). Such determinations can then be used as part of pricing and/or control strategies of a content and/or appliance provider, and/or controller of an administrative activity.

⁴ Audit information (related to usage of content received from the repository) in this example is securely received from end users 3310 by the receipt system 3362 of the clearinghouse. As indicated above, this system may process the audit information and pass some or all of the output of such a process to the billing system and/or transmit such output to appropriate content authors. Such passing of audit information employs secure VDE pathway of reporting information handling techniques. Audit information may also be passed to the analysis system in order to produce analysis results related to end user content usage for use by the end user, the repository, third party market researchers, and/or one or more authors. Analysis results may be based on a single audit transmission, a portion of an audit transmission, a collection of audit transmissions from a single end user and/or multiple end users 3310, or some combination of audit transmissions based on the subject of analysis (e.g. usage patterns for a given content element or collection of elements, usage of certain categories of content, payment histories, demographic usage patterns, etc.) The response system 3364 is used to send information to the end user to, for example, replenish a budget, deliver usage controls, update permissions information, and to transmit certain other information and/or messages requested and/or required by an end user in the course of their interaction with the clearinghouse. During the course of an end user's connections and transmissions to and from the clearinghouse, certain transactions (e.g. time, date, and/or purpose of a connection and/or transmission) may be recorded by the transaction system of the audit system to reflect requirements of the repository and/or authors.

Certain audit information may be transmitted to authors. For example, author 3306A may require that certain information gathered from an end user be transmitted to author 3306A with no processing by the audit system. In this case, the fact of the transmission may be recorded by the audit system, but author 3306A may have elected to perform their own usage analysis rather than (or in addition to) permitting the repository to access, otherwise process and/or otherwise use this information. The repository in this example may provide author 3306A with some of the usage information related to the repository's budget method received from one or more end users 3310 and

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method wherein any information collected with regards to electronic property rights may be transmitted to the author or owner as permitted by the VDE (column 289, line 57-column 290, line 63).

The examiner respectfully submits, that for the reasons stated above, the rejection under 35 U.S.C. 103(a) should be sustained.

Respectfully submitted,



Bradley B. Bayat, Esq.
Examiner
Art Unit 3621

bbb

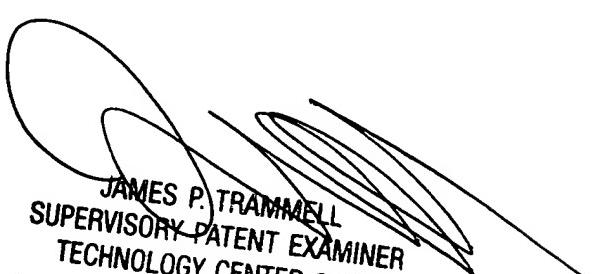
March 4, 2005

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generated by the payment of fees associated with such users' usage of content provided by author 3306A . In this case, author 3306A may be able to compare certain usage information related to content with the usage information related to the repository's budget method for the content to analyze patterns of usage (e.g. to analyze usage in light of fees, detect possible fraud, generate user profile information, etc.) Any usage fees collected by the clearinghouse associated with author 3306A's content that are due to author 3306A will be determined by the disbursement system of the clearinghouse. The disbursement system may include usage information (in complete or summary form) with any payments to author 3306A resulting from such a determination. Such payments and information reporting may be an entirely automated sequence of processes occurring within the VDE pathway from end user VDE secure subsystems, to the clearinghouse secure subsystem, to the author's secure subsystem.